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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,144	09/23/2003	Mark Trocki	VI/00-001.CIP.D3	2967
21140	7590	11/21/2006	EXAMINER	
GREGORY L BRADLEY MEDRAD INC ONE MEDRAD DRIVE INDIANOLA, PA 15051			MACNEILL, ELIZABETH	
			ART UNIT	PAPER NUMBER
			3767	

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

NT

Office Action Summary	Application No. 10/669,144	Applicant(s) TROCKI ET AL.	
	Examiner Elizabeth R. MacNeill	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 6-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6-11, 13 and 14 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to applicant's amendment submitted 19 October 2006.

The amendments submitted do not place the application in condition for allowance and the finality of the previous office action is withdrawn.

The indicated allowability of claims 1,6,7,8-11,13 and 14 is withdrawn in view of the newly discovered reference(s) to Barresi and Trull. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1,8, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant claims a "piston movably disposed at least partially within the housing and operable to drive the plunger of the syringe in a forward direction without a connective engagement therebetween to dispense fluid from the forward end of the body during an injection procedure, where in the piston comprises an elastomeric member adapted to expand in a radial direction to connectively engage the plunger to retract the plunger within the syringe." (This same phraseology is used in each independent claim (1,8 and 11))
3. The Examiner is unsure whether the connective engagement being described in the beginning of the claim is with regards to the piston and plunger or the housing and plunger or the piston and housing.

4. The Examiner believes the claim to be self-contradictory because at one point there is no connective engagement, but then a connective engagement exists between the piston and plunger when retracting the piston. A definition of "connective engagement," (and "connectively engage") consistent with the applicant's specification is requested.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Barresi et al (US 5,611,784)

Regarding claim 8, Barresi teaches a syringe (22), a body (21), a plunger (26) in an injector (20) with a housing (40), and a piston (not labeled, connected to cap 112 in Figure 2), with a collet member (110) which releasably grasps and retracts the plunger at 36 (Fig 2)

Regarding claims 9 and 10, the piston is adapted to drive and engage the plunger without regard to the orientation of the plunger with respect to the piston.

3. Claims 1,6,7 and 8-11,13 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Trull et al (US 5,947,929).

Regarding claims 1 and 8, Trull teaches a syringe (10), a body (12), a plunger (26) in an injector (60) with a housing (64), and a piston (240), with a collet (and elastomeric) member (238) which releasably grasps and retracts the plunger (Fig 13)

Regarding claim 11, Trull teaches a syringe (10), a body (12), a plunger (26) in an injector (60) with a housing (64), and a piston (240) with a sleeve member (242) and one or more plunger gripper members (232, 234) which are adapted to be biased by the sleeve member into engagement with the plunger upon retraction of the piston.

Regarding claims 6,7,9,10,13, and 14 the piston is adapted to drive and engage the plunger without regard to the orientation of the plunger with respect to the piston.

Allowable Subject Matter

4. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: Claim 12 recites the limitations of claim 11 (rejected above) with the further limitations of a collar connected to one end of the piston sleeve, the collar defining an opening through which the piston extends; a plunger cap connected to the collar, the plunger cap defining an interior space and a plurality of slots formed in a side thereof; a gripper extender disposed on an end of the piston within the interior space of the plunger cap; a plurality of grippers disposed through the slots and engageable with the

gripper extender, and a biasing member in contact with the piston sleeve; whereby, upon movement of the piston in a rearward direction, the biasing member biases movement of the piston sleeve to substantially prevent movement of the piston sleeve in the rearward direction to cause the gripper extender to push the plurality of grippers through the slots in the plunger cap into engagement with the plunger within the syringe. The structure of the plunger cap and collar with slots and gripper extenders, grippers, and biasing member are not suggested or taught by the prior art at the time the invention was made.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Staats et al (US 6,533,758); Duchon et al (US 2005/0015056), Kakimi et al (US 3,432,089), Goethel et al (US 6,196,999). Stade (US 4,705,509).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth R. MacNeill whose telephone number is (571)-272-9970. The examiner can normally be reached on 7:00-3:30pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3767

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ERM

*Elizabeth
MacAllister
11/15/06*

KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER

Kevin C. Sirmons